

REMARKS

By the above amendment which accompanies the RCE, claim 27 has been amended to overcome the objection thereto as noted by the Examiner. Additionally, new dependent claims 28 and 29 have been presented which depend from independent claims 16 and 20 and recite further features of the present invention, as will be discussed below, and new claims 30-37 have been presented, wherein claims 30 and 34 correspond to features of claims 16 and 20, while reciting additional features, as will be discussed below. It is noted that the dependent claims correspond to the dependent claims 31-33 and 35-37 previously submitted in this application.

With regard to the withdrawal from consideration of claims 18, 19, 22, 23, 26 and 27, applicants submit that generic claims readable on the elected species are present in this application and upon allowance thereof, the aforementioned dependent claims which stand withdrawn from consideration should be considered.

As to the rejection of claims 16, 17, 20, 21, 24 and 25 under 35 U.S.C. 102(e) as being anticipated by Kamijima (US 6,549,370), this rejection is traversed is traversed, and reconsideration and withdrawal of the rejection are respectfully requested.

At the outset, as to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and

that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In setting forth the rejection based upon Kamijima, the Examiner presents a figure corresponding to Fig. 12 of Kamijima and annotates such figure with regard to what is considered a "wider step portion" based upon the Examiner's understanding. Applicants submit that this position by the Examiner is in error, and what the Examiner considers to be a wider step portion is, in fact, part of an insulating layer 13 which is not illustrated in this figure. Reference is made to the attached Sketches A-D which represent revisions of Fig. 12 of Kamijima to more clearly illustrate the insulating film 11 and insulating layer 13 thereof, wherein Sketch B represents an enlargement of Sketch A and Sketch D represents an enlargement of Sketch C.

Referring to Fig. 7A of Kamijima, and as described in cols. 9 and 10 of this patent, an insulating layer 13 is formed over the coil 12, then polished through CMP, and the surface is flattened. Thereafter, the recording gap layer 14 and the insulating layer 13 therebelow are etched, and finally the film structure as illustrated in Fig. 11 and described at col. 10, lines 52-61, is obtained, wherein an air bearing surface 30 is provided. Applicants submit that by the aforementioned fabrication process, Fig. 12 of Kamijima apparently shows the result by finishing the etching through from the "recording gap layer 14" to the "insulating layer 13" by masking of the "top pole 15". Therefore, applicants submit that Fig. 12 of Kamijima, and as utilized by the Examiner, fails to properly illustrate the part of the "insulating film 11", which is now represented by the slanted lines or hatched portion as illustrated in the revised Fig. 12 of Sketches A-D submitted herewith. As is apparent from the revised Fig. 12 of Sketches A-D, the "projection step portion" as pointed out by the Examiner is only provided on the air bearing surface side in view of the proper illustration of the

"insulating film 11" and in the portion remote from the "projection step portion", i.e. on the other side of the "insulating film 11", is provided the "insulating layer 13" as clearly illustrated in Sketches A-D of the revision of Fig. 12.

Applicants submit that as is apparent from the Sketches A-D of the revised Fig. 12, based upon the disclosure of Kamijima, contrary to the position set forth by the Examiner, Kamijima fails to disclose or teach in the sense of 35 U.S.C. 102 the feature of a "wider step portion" or a "pair of wider step areas" or a "width in a track width direction of the projection step portion at a predetermined end from the air bearing surface is wider than a width in the track width direction of the upper magnetic pole at the predetermined depth from the air bearing surface" as recited in each of independent claims 16, 20 and 24 and the other claimed features of the independent and dependent claims. Applicants submit that there is no disclosure in Kamijima of the wider step portion or other features as recited in the independent and dependent claims of this application, and only due to lack of proper illustration in Fig. 12 of Kamijima can the Examiner attempt to present the argument as presented. However, in light of the attached Sketches A-D, which properly illustrate the insulating film 11 and the insulating layer 13, it is apparent that Kamijima fails to disclose the claimed features of the independent and dependent claims of this application. Thus, applicants submit that the independent claims and therewith the dependent claims patentably distinguish over Kamijima and all claims should be considered allowable thereover.

With respect to the dependent claims which stand withdrawn from consideration, applicants note that whether or not such claims are readable on the elected species, the independent claims represent generic claims and upon allowance of a generic claim, applicant is entitled to consideration of additional species, which should be considered allowable with the parent claims.

With respect to the newly dependent added 28 and 29 and independent claims 30 and 34 claims and the features recited thereby, applicants submit that Kamijima also fails to disclose the additional recited feature of a distance from the air bearing surface to an edge of the upper magnetic pole at a predetermined track direction shift position is longer than a distance from the air bearing surface to an edge of the wider step portion at the predetermined track direction shift position.

Looking to Fig. 7 of the drawings of this application, It is noted that the broken line on the wider step portion 29 represents the position of the slanted or flared edge portion of the upper magnetic pole 17 with respect thereto. Thus, considering a predetermined track direction shift position as a position shifted to the right of the right side edge of the step projection 27 at the air bearing surface, it is apparent that a distance therefrom to the broken line representing the edge of the upper magnetic pole is longer than a distance therefrom to the edge of the wider step portion 29, and applicants submit that these recited features are not disclosed or taught by Kamijima.

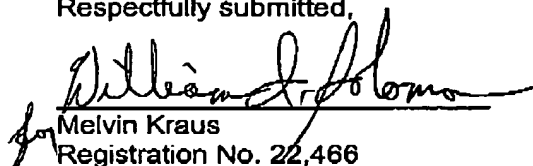
Further, as pointed out above, Kamijima also fails to disclose the feature of a wider step portion or a pair of wider step areas as recited in independent claims 30 and 34. Thus, these claims should also be considered allowable at this time.

In view of the above amendments and remarks, applicants submit that all claims present in this application patentably distinguish over Kamijima and should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing

of this paper, including extension of time fees, to Deposit Account No. 01-2135
(520.40591X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

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